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Patent

U.S. Appl. No.: 10/031,165 / API-1038-US-PCT

Reply to the Office Action of 28 September 2007

Remarks / Arguments

The applicants herein respond to the Office Action mailed 28 September 2007. The applicants submit the following additional papers with this transmission: 1) a Facsimile Cover Sheet; 2) a Certificate of Transmission under 37 CFR 1.8 (PTO/SB/97); 3) a Transmittal Form (PTO/SB/21); 4) a Petition for a Three Month Extension of Time (PTO/SB/22); and 5) the applicants' substantive Amendment and Response (14 pages plus 3 pages of Attachments (Appendices A, B, and C)).

The 28 September 2007 Office Action set a three-month Shortened Statutory Period of until 28 December 2007 for submission of a Responsive communication. The applicants' response is timely in view of the petition for a three month extension. The applicants authorize the Director to charge, or credit any overpayment, associated with this communication to USPTO Deposit Account (No.: 50-0244).

Claims 1-11 and 21-24 are currently pending. In the previous paper claims 1, 2, 4, 7, 8, and 21-24 were withdrawn without prejudice. Claims 3, 5, 6 and 9-11 are currently under examination.

Applicants herein amend claims 3, 5, 9, and 10 without in acquiescing to the Examiner's arguments in order to advance their business interests and the prosecution of the instant application. The applicants specifically reserve the right to prosecute the original, or a similar, claims in the future. The amendments to claims 3, 5, 9, and 10 are fully supported by the specification and do not add new matter.

The Examiner made the following objections and rejections in the 28 September 2007 Office Action as set forth below:

1. The Examiner asked that several objections to the Specification be addressed as follows:
 - a. Paragraph [0001] of the Specification be amended (*See*, Office Action, ¶ 7(a));
 - b. The Examiner asked that amendments to Specification submitted in the 17 January 2002 paper be made compliant with 37 C.F.R. §1.121 (*See*, Office Action, ¶ 7(b));
 - c. The Examiner asked the sequence described at line 26 of page 39 of the Specification be given a SEQ ID number compliant with 37 C.F.R. §§1.821-1.825 (*See*, Office Action, ¶ 7(c)); and
 - d. The Examiner asked that the designation of the sequence described as both SEQ ID NO: 40 and SEQ ID NO: 51 be clarified (*See*, Office Action, ¶ 7(d)); and
2. Claims 3 and 9 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly not being enabled (*See*, Office Action, ¶ 8);
3. Claims 3, 5, 6, and 9-10 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite as follows:
 - a. Claim 3 is vague (*See*, Office Action, ¶ 10(a));
 - b. Claim 3 is indefinite (*See*, Office Action, ¶ 10(b));
 - c. Claim 9 is indefinite (*See*, Office Action, ¶ 10(c));
 - d. Claim 3 is vague and indefinite (*See*, Office Action, ¶ 10(d));
 - e. Claim 5 lacks proper antecedent basis (*See*, Office Action, ¶ 10(e));
 - f. Claim 9 lacks proper antecedent basis (*See*, Office Action, ¶ 10(f));
 - g. Claim 10 lacks proper antecedent basis (*See*, Office Action, ¶ 10(g)); and
 - h. Claims 5, 6, and 9-11 are indefinite (*See*, Office Action, ¶ 10(h)); and

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4. Claims 3, 5, 6, and 9-11 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by WO 96/34960 (hereinafter the '34960 publication) (*See*, Office Action, ¶ 12).

The amendments and remarks presented herein are intended to be fully responsive to the Examiner's concerns, to advance the prosecution of the present application, and to place the application in condition for allowance.

1. The Objection to Specification Paragraph

A. The Examiner asked that the applicants amend the paragraph beginning at line 5 page 1 of the Specification to reflect the fact that the priority document, U.S. Ser. No.: 09/361,619 filed July 27, 1999, has since been abandoned. The applicants have made the requested amendment to the Specification. (*See*, Office Action, ¶ 7(a)). Applicants respectfully requests that this objection be withdrawn.

B. The Examiner asked that amendments to the Specification submitted in the 17 January 2002 Preliminary Amendment be made compliant with 37 C.F.R. §1.121. (*See*, Office Action, ¶ 7(b)). The Preliminary Amendment is unfortunately missing from the applicants' paper and electronic records for the application; moreover, "Image File Wrapper" information for the instant case is not available electronically from the USPTO via the PAIR system. Thus, at this time the applicants are not able to specifically address and/or correct any substantive deficiency in the amendments to the Specification were submitted in the 17 January 2002 Preliminary Amendment.

Interestingly, applicants further note that the USPTO's official filing date this reported for the instant application is 4 October 2002. (*See*, Appendix A, providing a copy of the Recordation of Assignment reporting that the instant 10/031,165 application has a filing date of 4 October 2002; and Appendix B, PAIR: Child Continuity Data report for the parent 09/361,619 application, now abandoned, stating that the instant 10/031,165 application has 4 October 2002 filing date). The filing date accorded by the USPTO is actually later then the mailing date of the Preliminary Amendment at issue. Also please notice that the instant application is a National Phase entry of the parent 09/361,619 application filed 27 July 1999, thus the instant application must have a filing of no later that 27 July 2000. This comports with the applicants' internal records for this instant application which report a 26 July 2000 filing date. Unfortunately, the date stamped Filing Receipt is not presently available. That said, the filing date reported by the USPTO, as seen in Appendices A and B, is apparently incorrect.

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The applicants' delay in addressing these issues is due to break in the continuity of representatives handling the prosecution of this application. The patent agent who was previously responsible for prosecuting the instant application recently left the company. Resolution of the Examiner's objection concerning the non-complaint 17 January 2002 Preliminary Amendment and the priority issue requires obtaining a copy of the file history from the USPTO. A request for the file history is being made with the submission of this paper. The applicants respectfully ask that the Examiner hold the instant objection in abeyance until the file history is obtained and all of the papers in it are considered.

C. The Examiner asked that the sequence described at line 26 of page 39 of the Specification be given a SEQ ID number compliant with 37 C.F.R. §§1.821-1.825. (*See*, Office Action, ¶ 7(c)). The applicants have amended the Specification accordingly.

D. The Examiner asked that the designation of the sequence described as being both SEQ ID NO: 40 and SEQ ID NO: 51 be clarified. (*See*, Office Action, ¶ 7(d)). The SEQ ID NO inserted at line 3 of page 40 was made in error. The sequence VVALK had previously been given the designation SEQ ID NO: 40 at line 23 of page 39. Proper amendment to the Specification has been made.

2. The Pending Claims are Enabled

Claims 3 and 9 are rejected as allegedly not being enabled. Applicants provide as an attachment hereto (Attachment C) a copy of the official ATCC deposit receipt dated 8 January 1999 pertinent to the issue of enablement. Applicants respectfully submit that the above noted remarks and evidence should be sufficient to demonstrate the enablement of present Claims 3 and 9 throughout their entire scope. Applicants respectfully request this rejection be withdrawn.

3. The Pending Claims are Definite

A. Claim 3 is vague for recitation of the term "derived." (*See*, Office Action, ¶ 10(a)). While it is not specifically mentioned which instances of the term "derived" are of concern, the applicants have removed the term in each instance, subparagraphs (b), (d), and (f), where it had been recited.

B. Claim 3 is indefinite for recitation of the term "set forth in Figure 21." (*See*, Office Action, ¶ 10(b)). While it is not specifically mentioned which instances of the term "set forth in Figure 21" are of concern, the applicants have removed the term in each instance, subparagraphs (c), (d), (e), and

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(f), where it had been recited. Applicants have also removed the term "Figure 8" recited in subparagraph (a) of claim 3.

C. Claim 9 is indefinite for recitation of the term "set forth in Figure 23." (*See*, Office Action, ¶ 10(c)). Applicants have removed the term "Figure 23" recited in claim 9.

D. Claim 3 is vague and indefinite. (*See*, Office Action, ¶ 10(d)). Applicants have clarified the presently intended claim scope of said claim 3 as it relates to the deleted subparagraph (f).

E. Claim 5 lack proper antecedent basis therein. (*See*, Office Action, ¶ 10(e)). Applicants have clarified the presently intended claim scope of said claim 5. Proper antecedent basis is now believed to be recited in claim 5.

F. Claim 9 lacks proper antecedent basis. (*See*, Office Action, ¶ 10(f)). Applicants have clarified the presently intended claim scope of said claim 9. Proper antecedent basis is now believed to be recited in claim 9.

G. Claim 10 lacks proper antecedent basis. (*See*, Office Action, ¶ 10(g)). Applicants have clarified the presently intended claim scope of said claim 10. Proper antecedent basis is now believed to be recited in claim 10.

H. Claims 5, 6, and 9-11 are indefinite because of the vagueness or indefiniteness in base claim 3. (*See*, Office Action, ¶ 10(h)). The above mentioned amendments to claim 3 are believed to be sufficient to warrant the withdrawal of this rejection.

The reasons stated above applicants respectfully request withdrawal of all of the alleged vagueness and/or indefiniteness rejections over the pending claims.

4. The Pending Claims are Not Anticipated

Claim 3, and claims 5, 6, and 9-11 dependent thereon, were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by WO 96/34960 (hereinafter the '34960 publication) (*See*, Office Action, ¶ 12). In particular, the Examiner argues that '34960 publication teaches every limitation of claim 3

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subparagraph (f). Applicants must respectfully disagree. Nevertheless, the amendments made to claim 3, and in particular, the deletion of subparagraph (f), made for other reasons as explained above, moot this rejection. Applicants request this rejection be withdrawn.

The applicants respectfully request reconsideration of the pending claim in view of the amendments and remarks presented herein. The applicants believe that the amendments and remarks presented herein overcome all of the Examiner's stated concerns. Should the Examiner have any questions concerning this application, she is invited to contact the undersigned.

Respectfully submitted,

Date: 28 MARCH 2008

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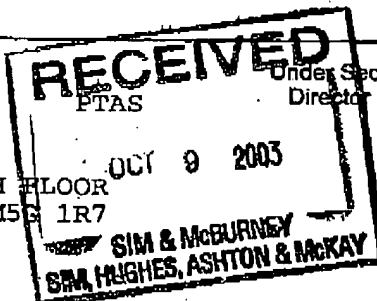
APPENDIX A



UNITED STATES
PATENT AND
TRADEMARK OFFICE

SEPTEMBER 30, 2003

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Under Secretary of Commerce For Intellectual Property and
Director of the United States Patent and Trademark Office
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RECORDATION DATE: 04/28/2003

REEL/FRAME: 014008/0307
NUMBER OF PAGES: 7

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

LOOSMORE, SHEENA M.

DOC DATE: 02/07/2002

ASSIGNOR:

YANG, YAN-PING

DOC DATE: 02/07/2002

ASSIGNOR:

KLEIN, MICHEAL H.

DOC DATE: 02/07/2002

ASSIGNEE:

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SERIAL NUMBER: 10031165
PATENT NUMBER:

FILING DATE: 10/04/2002
ISSUE DATE:



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APPENDIX B



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09/361,619

RECOMBINANT HIGH MOLECULAR WEIGHT M/
OUTER MEMBRANE PROTEIN OR MORAXELLA

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Parent Continuity Data

Description	Parent Number	Parent Filing or 371(c) Date	Parent Status
No Parent Continuity Data Found.			

Child Continuity Data

10/031,165 filed on 10-04-2002 which is Pending claims the benefit of 09/11/013,711 filed on 12-16-2004 which is Pending claims the benefit of 09/11/013,759 filed on 12-16-2004 which is Pending claims the benefit of 09/

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APPENDIX C

ATCC

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BUDAPEST TREATY ON THE INTERNATIONAL RECOGNITION OF
THE DEPOSIT OF MICROORGANISMS FOR THE PURPOSES OF PATENT PROCEDURE

INTERNATIONAL FORM

RECEIPT IN THE CASE OF AN ORIGINAL DEPOSIT ISSUED PURSUANT TO RULE 7.3
AND VIABILITY STATEMENT ISSUED PURSUANT TO RULE 10.2

To: (Name and Address of Depositor or Attorney)

Connaught Laboratories Ltd.
Attn: Gavin Zealey
1755 Steeles Avenue
Toronto, Ontario, Canada M2R 3T4

Deposited on Behalf of: Connaught Laboratories Ltd.

Identification Reference by Depositor:

ATCC Designation

Plasmid DNA pKS294
Plasmid DNA pKS348

203528
203529

The deposits were accompanied by: a scientific description a proposed taxonomic description indicated above. The deposits were received December 17, 1998 by this International Depository Authority and have been accepted.

AT YOUR REQUEST: X We will inform you of requests for the strains for 30 years.

The strains will be made available if a patent office signatory to the Budapest Treaty certifies one's right to receive, or if a U.S. Patent is issued citing the strains, and ATCC is instructed by the United States Patent & Trademark Office or the depositor to release said strains.

If the cultures should die or be destroyed during the effective term of the deposit, it shall be your responsibility to replace them with living cultures of the same.

The strains will be maintained for a period of at least 30 years from date of deposit, or five years after the most recent request for a sample, whichever is longer. The United States and many other countries are signatory to the Budapest Treaty. ✓

The viability of the cultures cited above was tested January 6, 1999. On that date, the cultures were viable.

International Depository Authority: American Type Culture Collection, Manassas, VA 20110-2209 USA.

Signature of person having authority to represent ATCC:

Barbara M. Hailey
Barbara M. Hailey, Administrator, Patent Depository

Date: January 8, 1999

cc: Michael Stewart